REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 25, 2003. Claims 1 through 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,953,330 issued to Colmant, et al. ("*Colmant*") in view of U.S. Patent No. 6,310,891 issued to Dove ("*Dove*"). Claims 2, 4, 11, 16, and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Colmant* and *Dove*, and further in view of U.S. Patent No. 5,481,771 issued to Irwin ("*Irwin*"). Claims 6 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Colmant, Dove, Irwin,* and further in view of U.S. Patent No. 6,005,865 issued to Lewis ("*Lewis*"). Applicants traverse these rejections for reasons stated below. Reconsideration and favorable action are requested.

INFORMATION DISCLOSURE STATEMENT

The Examiner has not confirmed that he has considered the references listed in PTO Form 1449, lines G-T of the IDS filed on August 30, 2002. Applicants respectfully request the Examiner to confirm consideration by initialing the appropriate column of the PTO Form 1449.

SECTION 103 REJECTIONS

Claim 1 is allowable because the combination of *Colmant* and *Dove* does not teach or suggest "a switch controller operable to determine a type for each traffic cell [transported by a frame] received at the switch interface and to determine based on the type for a traffic cell an address for storing the traffic cell in a switch memory. . . ," as recited by Claim 1. The Examiner concedes that a frame having different traffic cells is not disclosed in *Colmant*, but then asserts that *Dove* discloses such a frame and that it would have been obvious for one skilled in the art to modify the system of *Colmant* in view of *Dove* to produce the switch control of Claim 1. However, the Examiner's assertions are incorrect because modifying the teachings of *Colmant* in view of *Dove* would defeat the respective purposes of both references, and thus there is no motivation to modify *Colmant* in view of *Dove*.

The Examiner is not allowed to combine references to reject a claim unless he shows ". . . some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. §2143. In explaining this requirement, M.P.E.P. §2143.01

states that "[t]he proposed modification cannot render the prior art unsatisfactory for its intended purpose." If so, then ". . . there is no suggestion or motivation to make the proposed modification." Such is the case here. *Dove* teaches a method of preventing address collisions between time multiplexed cells of frames by scheduling a mixture of synchronous and asynchronous cells in each frame. (See Column 1, Lines 58 through 63 and Column 2, Lines 32 through 40.) Thus, each frame transmitted according to *Dove* includes synchronous cells that are interspersed with asynchronous cells. To the contrary, *Colmant* teaches efficient bandwidth management in an FDDI ring by transmitting all synchronous traffic first, and then transmitting all asynchronous traffic. (see column 13, lines 33-51). To do this, each frame transmitted according to *Colmant* cannot have a mixture of synchronous and asynchronous cells.

Thus, using the teachings of *Dove* and *Colmant* would render either *Dove* or *Colmant* unsatisfactory for its intended purpose, which makes the proposed combination of these two references improper. For example, scheduling a frame of *Dove* using *Colmant* would render *Colmant* unsatisfactory for its intended purpose of efficient bandwidth management because the synchronous cells would be mixed with asynchronous cells instead of being prioritized. On the other hand, prioritizing the transmission of traffic cells according to *Colmant* would render *Dove* unsatisfactory for its intended purpose of avoiding address collisions at the traffic cells' destination because, regardless of how the frame of *Dove* is processed at the system of *Colmant*, all synchronous cells of the frame of *Dove* would be transmitted to the destination first before the transmission of asynchronous cells. As such, address collisions will not be prevented at the destination. Thus, one skilled in the art would not be motivated to modify the FDDI station of *Colmant* in view of the frame of *Dove*. For at least this reason, Claim 1 is allowable.

The Examiner argues that there is motivation to modify *Colmant* in view of *Dove* for the reason that ". . . each frame [of *Dove*] is able to carry different data types. This would be important in a system that needs a certain amount of data to be received in every frame, such as voice communications that require a minimum quality of service to maintain a conversation." However, this argument is circular and lacks meaningful support; it essentially amounts to a bare assertion that there is a motivation to modify *Colmant* in view of *Dove* because some hypothetical system may require such a modification. Further, the only example of this hypothetical system cited by the Examiner – a voice communications

system – in fact does not require such a modification and the Examiner is wrong in this regard.[1] In essence, the Examiner's assertion concerning the requisite motivation to combine the cited references is akin to a statement that *Colmant* and *Dove* <u>can</u> be combined, which is expressly stated in §2143.01 of M.P.E.P. as an improper ground for an obviousness rejection. ("The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious . . . ." - §2143.01, M.P.E.P.). To properly combine references, the Examiner is required to identify a portion of a cited reference that shows some suggestion or motivation to combine the references or make a prima facie showing using some other reference that the motivation to combine the cited references is generally available to one skilled in the art. The Examiner has done neither, and if the Examiner continues to maintain this position, Applicants respectfully request the Examiner to identify a portion of a reference showing the motivation to combine the cited references. If the Examiner's position is based on personal knowledge, then Applicants respectfully request the Examiner to produce an affidavit stating the facts relied upon as specifically as possible, pursuant to M.P.E.P. §2144.03. Because there is no motivation to modify *Colmant* in view of *Dove*, Claim 1 is allowable. Reconsideration and favorable action are requested.

Claim 11 is allowable for reasons analogous to those provided in conjunction with Claim 1. Further, Claim 11 is allowable because there is no motivation to combine *Irwin* with the teachings of either *Colmant* or *Dove* to show "a switch interface operable . . . to extract a header for a traffic cell from the time slot transporting the traffic cell, and to provide the header to a switch controller . . . [that is] operable to determine a type for the traffic cell based on the header . . . ," as recited in Claim 11. The Examiner argues that there is motivation for one skilled in the art to combine *Colmant* with *Irwin* because "it would allow packets of different formats to be sent to separate queues and ordered for proper sequence prior to transmission." (See page 7, lines 11-13, Office Action). This argument is also circular; it essentially states that the combination to produce a function is desired because the

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[1] The Examiner cites voice communications as requiring such a modification, stating that a voice communications system requires certain amount of data to be received in each frame for minimum quality of service. However, this appears to be incorrect because *Colmant* teaches supporting multimedia applications – which, as well known in the art, includes voice communications – without transmitting multimedia data in each frame. (see Abstract section and column 14, lines 36-41 of *Colmant*). And as conceded by the Examiner, *Colmant* does not transmit a frame that includes multiple types of traffic cells, which leads to the conclusion that voice communications does not require data to be received in each frame for minimum quality of service, and thus would not require data to be received in a frame of *Dove*. Further, it stands to reason that receiving all

function would be desirable. But more importantly, *Colmant* **already** teaches a controller 122 that is operable to store frames in FRB 130 based on the type of the frame, which implies that controller 122 is operable to determine the type of a frame. Thus, one skilled in the art would not be motivated to modify *Colmant* to extract a header of a frame to determine the frame type when *Colmant* **already** has a device for distinguishing the types of frames. Without more, the Examiner's argument regarding the motivation to combine is akin to a statement that *Colmant* and *Irwin* <u>can</u> be combined, which is expressly stated in §2143.01 of M.P.E.P. as an improper ground for an obviousness rejection. ("The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious . . . ." - §2143.01, M.P.E.P. See also *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) ("Although a prior art device may be capable of being modified to run at a claimed speed, there must be a suggestion or motivation in the reference to do so."). Thus, the Examiner's argument regarding the motivation to combine *Colmant* and *Irwin* falls well short of the standard set forth in M.P.E.P. §2143, and Claim 11 is allowable. Reconsideration and favorable action are requested.

Claim 15 is allowable for reasons analogous to those provided in conjunction with Claim 1. More specifically, neither *Colmant* nor *Dove* teaches or suggests "determining a type for each traffic cell based on the header of the traffic cell; determining an address in the switch memory for storing the traffic cell based on the type. . . ," as recited by Claim 15. Reconsideration and favorable action are requested.

Claim 24 is allowable for reasons analogous to those provided in conjunction with Claim 1. More specifically, none of the cited references teaches or suggests "software . . . operable to . . . determine a type for each traffic cell based on the header for the traffic cell, to determine an address in an switch memory for storing the traffic cell based on the type," as recited by Claim 24. Reconsideration and favorable action are requested.

Claim 33 is allowable for reasons analogous to those provided in conjunction with Claim 1. More specifically, none of the cited references teaches or suggests "a controlling means for determining a type for each traffic cell of the frame based on the header for the traffic cell, for determining an address in a data storage means for storing the traffic cell

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synchronous data first rather than receiving some data in every frame would increase, and not decrease, the quality of service in voice communications.

based on the type . . .," as recited by Claim 33. Reconsideration and favorable action are requested.

As depending from their respectively allowable independent claims, dependent claims 2-10, 12-14, 16-23, and 25-32 are also allowable. Further, Claims 2, 4, 16, and 25 are allowable for reasons analogous to those provided in conjunction with Claims 1 and 11. Reconsideration and favorable action are requested.
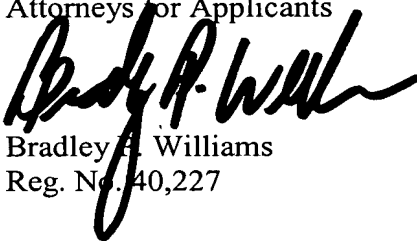
CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, please feel free to contact the undersigned attorney for Applicants.

No fee is believed to be due, but the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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